REMARKS

Claim Amendments

Claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 are pending and under current examination. By this Amendment, Applicants have amended claims 1, 13, 25, and 37 solely to improve clarity. No new matter was introduced.

Office Action

The Final Office Action (1) rejected claims 1, 4-13, 16-25, 28-37, and 40-48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,422,821 ("*Allen*") in view of a webpage for "NCOA Description" from www.Anchorcomputer.com (Reference U of the PTO-892) ("*Anchor*"); and (2) rejected claims 57-64 under 35 U.S.C. § 103(a) as being unpatentable over *Allen* in view of U.S. Patent Application Pub. No. 2002/0029202 A1 ("*Lopez*") and in further view of *Anchor*.

Regarding Final Office Action's Response to Arguments

Applicants respectfully maintain that *Allen* does not teach an incorrect address consistent with the plain meaning of the term as defined in claim 1, because claim 1 specifically defines an incorrect address to be one that "contains a delivery format error." *Allen's* former, no longer valid addresses cannot fall within this meaning because the former addresses match a predetermined deliverable address format set forth in the NCOA database. *See*, *Allen*, col. 1:25; col. 4:49-52; col. 6:65-7:4. As a result, *Allen's* former addresses stored in the NCOA database do not contain a delivery format error as recited by claim 1. For at least this reason, *Allen's* former addresses stored in the NCOA database do not constitute "an incorrect address that contains a delivery format error," as recited by claim 1.

In the "Response to Arguments" section, the Final Office Action alleges that "*Anchor* describes a system that not only corrects incorrect addresses due to moves, but also due to delivery format errors in the Zip codes." O.A. at 4. Applicants respectfully submit that even if this is true, *Anchor* fails to disclose storing the incorrect address with the delivery format error as part of the correction process. Neither *Anchor* nor *Allen* disclose :storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error," as recited by the independent claims. Both *Anchor* and *Allen* merely disclose storing former addresses, which do not contain delivery format errors for the reasons discussed above. Furthermore, disclosing correction of a Zip code error in an address does not teach or suggest that the address with the zip code error is stored with the corrected address as a resolved address.

Therefore, for at least the above reasons, the stored addresses of *Allen* and *Anchor* in the NCOA database do not constitute "a resolved address comprising ... an incorrect address that contains a delivery format error," as recited in amended claim 1 (emphasis added).

Regarding Rejections of Claims under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejections of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64 under 35 U.S.C. § 103(a). No *prima facie* case of obviousness has been established with respect to these claims.

To establish a *prima facie* case of obviousness, the Final Office Action must, among other things, determine the scope and content of the prior art and ascertain the differences between the claimed invention and the prior art. *See* M.P.E.P.

§ 2144.08(II)(A). Furthermore, the Final Office Action must make findings with respect to all of the claim limitations and must make "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *See Id.* §§ 2143.03 and 2141(III).

Claim 1 recites, among other things, the following elements:

> receiving a first instance of an incorrect address that contains a delivery format error, the incorrect address being associated with a first item;
>
> resolving the first instance of the incorrect address to determine a correct address in a predetermined delivery format by using at least one of a plurality of address resolution processes;
>
> in response to resolving the first instance of the incorrect address, storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error; [and] . . .
>
> comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address.

As discussed above, *Allen* does not teach or suggest an "incorrect address that contains a delivery format error," as recited in amended claim 1, because *Allen's* former, no longer valid address that is stored in the USPS National Change of Address NCOA database does not contain "a delivery format error." As a result, *Allen* does not teach or suggest, among other things, "storing a resolved address comprising . . . the incorrect address that contains the delivery format error" or "comparing the second instance of the incorrect address to the stored resolved address," as recited in amended claim 1.

Indeed, the Final Office Action admits that *Allen* does not teach or suggest "storing a resolved address in a database, the resolved address comprising the correct

address and the first instance of the incorrect address that contains the delivery format error." O.A. at 5. Because *Allen* does not disclose this, *Allen* cannot disclose "in response to resolving the first instance of the incorrect address, storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error" or "comparing the second instance of the incorrect address to the stored resolved address," as recited in amended claim 1 (emphasis added).

The Final Office Action relies on *Anchor* to allegedly cure the deficiencies of *Allen*. *Anchor* discloses "process[ing] your [list of addresses] and mak[ing] all necessary address corrections . . . [and] standardiz[ing] your addresses and add[ing] ZIP+4 Codes to your address file." *Anchor*, ¶ 7. The Final Office Action alleges that *Anchor* teaches "storing a resolved address in a database; the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error." O.A. at 5. Applicants respectfully disagree. However, assuming, without conceding, that *Anchor* teaches this, *Anchor* fails to teach this "in response to resolving the first instance of the incorrect address."

As discussed above, *Anchor* discloses generating corrected address records, but does not disclose storing the incorrect and the corrected address in response to resolving the incorrect address. Accordingly, *Anchor* does not disclose or suggest, among other things, "in response to resolving the first instance of the incorrect address, storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error," as recited in amended claim 1.

Moreover, *Anchor* does not disclose "comparing the second instance of the incorrect address to the stored resolved address," as recited in claim 1, for the same reasons as those discussed above with regard to *Allen*. As recited in claim 1, the stored resolved address is stored in response to resolving the incorrect address, and comprises the incorrect address that contains the delivery format error. *Anchor* does not disclose these elements. For at least these reasons, even if *Anchor* is combined with *Allen*, as proposed by the Final Office Action, the combination still fails to disclose at least "in response to resolving the first instance of the correct address, storing a resolved address comprising . . . the incorrect address that contains the delivery format error" and "comparing the second instance of the incorrect address to the stored resolved address," as recited in amended claim 1 ¶

The Final Office Action further relies on *Lopez* to allegedly cure the deficiencies of *Allen* and *Anchor*. However, like *Allen* and *Anchor*, *Lopez* also does not teach or suggest, among other things, "in response to resolving the first instance of the incorrect address, storing a resolved address in a database, the resolved address comprising the correct address and the first instance of the incorrect address that contains the delivery format error," as recited in amended claim 1. Furthermore, like *Allen* and *Anchor*, *Lopez* also does not teach or suggest "comparing the second instance of the incorrect address to the stored resolved address to determine that the second instance of the incorrect address matches the stored first instance of the incorrect address," as recited in amended claim 1 (emphasis added). The Final Office Action does not allege otherwise. Indeed, *Lopez* does not teach or suggest these elements. Therefore, *Lopez* does not cure the deficiencies of *Allen* and *Anchor*.

For at least the foregoing reasons, *Allen*, *Lopez*, and *Anchor*, whether taken alone or in combination, fail to teach or suggest the elements recited in amended claim 1, and the Final Office Action has incorrectly determined the scope and content of the prior art. Moreover, the undisclosed elements represent significant differences between the claimed invention as a whole and the prior art. Therefore, a *prima facie* case of obviousness has not been established for claim 1, and it is allowable over the cited references. Dependent claims 4-12 and 57-59 are also allowable, at least by virtue of their dependence from claim 1, as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Although of different scope, independent claims 13, 25, and 37, as amended, include elements similar to those discussed above in connection with amended claim 1. For at least the same reasons discussed above with respect to claim 1, independent claims 13, 25, and 37 are allowable over the cited references. Dependent claims 16-24, 28-36, 40-48, and 60-64 are also allowable, at least by virtue of their dependence from independent claims 13, 25, or 37, as well as by virtue of reciting additional elements not taught or suggested by the cited references.

Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejections of claims 1, 4-13, 16-25, 28-37, 40-48, and 57-64.

Conclusion

In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims.

The Final Office Action contains statements characterizing the related art and the claims. Regardless of whether any such statements are specifically identified herein,

Applicants decline to automatically subscribe to any statements in the Final Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: August 31, 2010

By: /Melanie Grover/
Melanie Grover
Reg. No. 63,599